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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,578	09/08/2003	Karen M. Cregan	0112300-1676	9870
29159	7590	08/17/2007		
BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690			EXAMINER HALL, ARTHUR O	
			ART UNIT 3709	PAPER NUMBER
			NOTIFICATION DATE 08/17/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

# Office Action Summary

Application No.

10/657,578

Applicant(s)

CREGAN ET AL.

Examiner

Arthur O. Hall

Art Unit

3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 12-20, 23-41 and 49-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 21-22, 42-48 and 57-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/11/2007.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

***Information Disclosure Statement***

The supplemental information disclosure statement (Supplemental IDS) submitted on 7/11/2007 has been acknowledged by the examiner.

***Response to Amendment***

Examiner acknowledges applicant's formal election of Species I of claims 1-11, 21-22, 42-48 and 57-58 without traverse and withdrawal of claims 12-20, 23-41 and 49-56 without prejudice or disclaimer in response to the restriction requirement, which satisfies the requirement to elect a species under 35 U.S.C. § 121.

Examiner acknowledges that applicants arguments directed to the rejection set forth under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) are persuasive, in part, in view of each of applicants amendments, and, in part, in view of applicants arguments, thus the rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) are withdrawn. However, a new ground of rejection under 35 U.S.C. 103(a) has been set forth below.

Examiner acknowledges applicant's amendment of Claim 22 removing reference to "any award" and adding provision of "an award equal to the sum of the first and second awards," which obviates the rejection to claim 22 as being indefinite as described in the non-final office action dated 4/9/2007. Therefore, Examiner withdraws further rejection of the claim.

Art Unit: 3709

Examiner acknowledges that Figs. 8C and 11B were inadvertently filed in this application in error. Examiner has requested of the appropriate group within the USPTO to transfer these drawings to the proper application, which is Application No. 10/953,599.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-11, 21-22, 42-48 and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Patent 6,855,054; hereinafter White) in view of McClintic (US Patent 6,905,405), and even further in view of Gauselmann (US Patent Application Publication 2004/0097280).

White alone or in combination with McClintic substantially teaches features of the claimed invention as previously described in the Office Action mailed on date 4/9/2007 incorporated herein by reference.

However, White alone or in combination with McClintic does not substantially teach "automatically" rearranging symbols and evaluating symbols based on winning combinations for each rearrangement as claimed. Therefore, attention is directed to Gauselmann, which teaches that if a triggering symbol has been generated, the symbols displayed by at least one display device are "automatically" rearranged (paragraphs 0031 and 0039, Gauselmann; it is disclosed that the symbols displayed on a display are shifted or rearranged automatically or under player control upon occurrence of a trigger symbol).

Gauselmann suggests that a device that provides a player with multiple chances of winning, specifically based on the occurrence of trigger symbols, will provide a player with greater excitement in the game and generate more revenue via gaming machines (paragraphs 0002-0005, Gauselmann).

Thus, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to modify White in view of the teachings of McClintic, and further in view of the teachings of Gauselmann for the purpose of exchanging the interchangeable or upgradeable symbol rearrangement or shifting features of White alone or in combination with McClintic with the automatic rearrangement and award evaluation features of Gauselmann in order to provide the

Art Unit: 3709

player with more excitement in the game and generate more gaming machine revenue by providing the player with more chances to win the game.

The claimed features of at least one processor, at least one display, each winning combination of displayed symbols resulting from the rearrangement of the indicated symbols and an award equal to the sum of the first and second awards do not appear to be disclosed in White alone or in combination with McClintic; therefore, attention is directed to Gauselmann, which teaches

that at least one processor is available (paragraph 0023 and Fig. 2, 60 and 65, Gauselmann; a CPU and a display controller are disclosed);

that at least one display is available (paragraph 0028, Gauselmann; a main video screen and a separate touch screen are disclosed);

that each winning combination of displayed symbols result from the rearrangement of the indicated symbols (paragraph 0030, Gauselmann; an award is determined to be granted based on winning symbol combinations made as a result of a trigger to shift or rearrange the symbols displayed to the player on a display); and

that an award equal to the sum of the first and second awards is provided (paragraph 0025, Gauselmann; various awards are disclosed that may be paid in sum to the player once winning combinations of symbols occur upon activation of the trigger symbol or symbols).

Thus, these new grounds of rejection are deemed to be proper. Therefore, this office action is made final.

### ***Response to Arguments***

Applicant's arguments filed on 7/11/2007 with respect to Examiners' rejection under 35 U.S.C. 102(b) have been fully considered and are persuasive in light of applicant's amendments reciting "automatic" rearrangement of symbols and arguments thereof. Hence, the rejection under 35 U.S.C. 102(b) has been withdrawn.

Applicant's arguments filed on 7/11/2007 with respect to Examiners' rejection under 35 U.S.C. 103(a) have been fully considered and are persuasive in light of applicant's amendments and arguments set forth above for the rejection under 35 U.S.C. 102(b). Hence, the rejection under 35 U.S.C. 103(a) has been withdrawn.

Therefore, applicants arguments have been deemed to be persuasive, in part, in view of each of applicants amendments, and, in part, in view of applicants arguments. However, Examiner has provided the above new grounds of rejection of the claims as unpatentable over White in view of McClintic, and even further in view of Gauselmann because each of the features of applicant's claimed invention continues to be disclosed in the prior art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3709

B US-4,611,811, Haase

C US-6,089,977 Bennett

D US-6,908,383 B2, Baerlocher et al.

E US-6,561,900 B1, Baerlocher et al.

F US-6,786,820 B2, Gerrard et al.

G US-2002/0016200 A1, Baerlocher et al.

H US-5,722,891, Inoue.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Art Unit: 3709

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur O. Hall whose telephone number is (571) 270-1814. The examiner can normally be reached on Mon - Fri, 8:00am - 5:00 pm, Alt Fri, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jackson can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AH   
8/7/2007

GARY JACKSON  
SUPERVISORY PATENT EXAMINER  
